

U.S. Serial No. 10/690,150
Amendment Dated August 29, 2005
Response To Office Action Dated June 2, 2005

REMARKS

The pending application was filed on October 21, 2003 with claims 1-25. The Examiner issued a Non-Final Office Action dated January 11, 2005 objecting to claims 9-10 and 16-17. However, the Examiner indicated that claims 9-10 and 16-17 would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. The Examiner also rejected claims 1-8, 10-15, and 18-25. A Response was filed April 11, 2005. The Examiner issued a Non-Final Office Action dated June 2, 2005 in which the Examiner objected to claims 3, 7-10, 14-19 and 22-25 and indicated that these claims would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. The Examiner also rejected claims 1, 2, 4-7, 11-13, 20 and 21. In particular, the Examiner rejected claims 1 and 21 under 35 U.S.C. §102(a) as being anticipated by U.S. Patent No. 5,743,337 to *MacDonald III* and rejected claims 2, 4, 5, 6, 12, 13, and 19 under 35 U.S.C. § 103(a) as being unpatentable over *MacDonald III* in view of United States Patent No. 4,423,829 to *Katz*.

The Undersigned Representative and the Examiner conducted a telephonic interview on July 20, 2005 in which cited prior art references *MacDonald III* and *Katz* were discussed. The Undersigned Representative thanks the Examiner for the interview as the interview was beneficial in moving the case forward. Possible amendments were discussed; however, no agreement was reached.

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Claims 1-25 remain pending in the patent application. Claims 1, 13, and 21 have been amended. In view of the amendments set forth above and the arguments set forth below, claims 1-25 are allowable, and the Examiner is respectfully requested to withdraw the rejections and issue a timely Notice of Allowance.

I. OBJECTION TO DRAWINGS

The Examiner objected to the drawings under 37 CFR 1.83(a) asserting that the drawings fail to show how the invention is fitted to a sprinkler head as described in the specification. Figure 1 has been amended in agreement with the Examiner's suggestion to depict a bladder of the invention positioned between a support structure of a fire sprinkler and an exhaust port of a fire sprinkler, as described in the specification. Thus, the objection has been overcome, and the Examiner is respectfully requested to withdraw the rejection.

II. CLAIM REJECTIONS UNDER 35 U.S.C. §102

The Examiner rejected claims 1 and 21 under 35 U.S.C. §102 as being anticipated by United States Patent No. 5,743,337 to *MacDonald III*. More specifically, the Examiner stated that *MacDonald III* discloses a bladder (282) and a method of using a bladder that is adapted to fit (once installed as shown) between a support structure (288) of a fire sprinkler and an exhaust port (not numbered) for the purpose of sealing the exhaust port of the fire sprinkler.

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MacDonald III discloses a device usable to relocate a fire sprinkler head while the system remains under pressure. *MacDonald III* discloses a removable cap, as shown in Figures 11 and 12, that is configured to be attached to a fire sprinkler head to create a watertight compartment around the sprinkler head so that the assemblage can be moved while the sprinkler system remains pressurized and operational. Figure 13 of *MacDonald III* discloses another embodiment in which the removable cap is replaced with a removable bladder having a threaded coupling configured to be threadably attached to a base of a fire sprinkler head.

Claim 1 has been amended and states in relevant part, "at least one bladder adapted to fit between a support structure of a fire sprinkler and an exhaust port of a fire sprinkler for sealing the exhaust port of the fire sprinkler by contacting an outer surface of the at least one bladder with the exhaust port, wherein the support structure extends outwardly from the fire sprinkler in front of the exhaust port" (emphasis added). The Examiner identified element 288 as the support structure disclosed in *MacDonald III* that anticipates claim 1. However, element 288 does not enable a bladder to be placed between the support structure and an exhaust port to secure the bladder such that an outer surface of the bladder is capable of contacting the exhaust port. Furthermore, *MacDonald III* does not disclose using the device disclosed therein to seal a fire sprinkler head after the head has been activated and water is rapidly flowing from the head. Rather, *MacDonald III* discloses installing the cap before

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water is discharged from the head to prevent accidental discharge. Moreover, attempting to threadably attach a cap or bladder to a fire sprinkler device when water is being discharged from the sprinkler would be nearly impossible because the water flowing from the fire sprinkler would be forcing the cap or bladder away from the exhaust port. Such is not the case with the claimed invention. Rather, the claimed bladder is configured to be placed between a support structure and the exhaust port so that an outer surface of the bladder contacts the exhaust port once the bladder has been inflated. Thus, claim 1 is allowable for at least these reasons, and the Examiner is respectfully requested to withdraw the rejection.

As concerning claim 21, claim 21 has been amended and states in relevant part "inserting a fire sprinkler discharge control device between a support structure of the fire sprinkler and an exhaust port of the fire sprinkler, wherein the support structure extends outwardly from the fire sprinkler in front of the exhaust port." As discussed in detail above regarding claim 1, *MacDonald III* discloses a removable cap, as shown in Figures 11 and 12, and a removable bladder, in Figure 13, that are configured to be attached to a fire sprinkler head to create a watertight compartment around the sprinkler head so that the assemblage can be moved while the sprinkler system remains pressurized and operational. *MacDonald III* does not disclose inserting a fire sprinkler discharge control device between a support structure of the fire sprinkler and an exhaust port in the fire sprinkler, nor does *MacDonald III* disclose a support structure extending outwardly from the fire sprinkler in front of the

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exhaust port. Thus, *MacDonald III* does not anticipate claim 21, and the Examiner is respectfully requested to withdraw the rejection.

III. CLAIM REJECTIONS UNDER 35 U.S.C. §103(a)

The Examiner rejected claims 2, 4, 5, 6, 12, 13 and 19 under 35 U.S.C. §103(a) as being unpatentable over *MacDonald III* in view of U.S. Patent No. 4,423,829 to *Katz*. The Examiner stated that *MacDonald III* discloses a bladder (282) and a method of using a bladder that is adapted to fit (once installed as shown) between a support structure (288) of a fire sprinkler and an exhaust port (not numbered) for the purpose of sealing the exhaust port of the fire sprinkler. However, the Examiner stated that *MacDonald III* does not disclose use of a valve at the inlet of the flexible bladder, a clamp, or an inner bladder. The Examiner further stated that *Katz* discloses a valve assembly coupled to a device having a bladder. The Examiner stated that as concerning claims 4 and 19, that *Katz* discloses a clamp that couples a bladder to the valve. The Examiner stated that as concerning claims 5 and 13, Figures 8-11 of *Katz* disclose a version of an outer bladder (36) having an inner bladder (88). The Examiner also stated that as concerning claims 6 and 12, the inner bladder (88) is constructed of materials impermeable to fluids. The Examiner concluded that it would have been obvious to one of ordinary skill in the art to modify *MacDonald III* with the inner bladder, valve, and clamp disclosed in *Katz* to form a device that can seal a fire sprinkler once the fire sprinkler is activated.

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"To establish a *prima facie* case of obviousness, three basic criteria must be met. First there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or reference when combined) must teach or suggest all of the claim limitations." MPEP 2143 (emphasis added). In addition, "[t]he teaching or suggestion to make the claimed combination and the reasonable expectation of success must be both found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). In this case, *Katz* discloses an apparatus for containing and dispensing a liquid under pressure. The apparatus disclosed in *Katz* is formed from a resilient tubular container with a flexible inner sleeve for containing a fluid. The *Katz* reference discloses use of the apparatus to contain fluids in the container and "to permit selective amounts of the pressurized fluid to exit the flexible container" column 3, lines 32-33. *Katz* does not disclose, or even suggest, using the container disclosed in *Katz* as a fire sprinkler discharge device. In *Katz*, the resilient container contains the liquid. In contrast, the bladder in the claimed invention is used only as a stopper of sorts to block the flow of the liquid. These are completely different issues. The Examiner's conclusion that the apparatus disclosed in *Katz* may be used as a fire sprinkler control device is impermissible hindsight.

Claims 2, 4, 5, 6 and 12 depend from amended claim 1, which is allowable for the reasons previously set forth. Thus, claim 2, 4, 5, 6, and 12 are allowable as well.

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Furthermore, neither *Katz* nor *MacDonald III* discloses "at least one bladder adapted to fit between a support structure of a fire sprinkler and an exhaust port of a fire sprinkler for sealing the exhaust port of the fire sprinkler by contacting an outer surface of the at least one bladder with the exhaust port, wherein the support structure extends outwardly from the fire sprinkler in front of the exhaust port" as recited in amended claim 1. Thus, for at least these reasons, claims 2, 4, 5, 6, and 12 are allowable.

Claim 13 has been amended and states in relevant part "at least one outer bladder adapted to fit between a support structure and an exhaust port of a fire sprinkler for sealing the exhaust port by contacting an outer surface of the at least one bladder with the exhaust port, wherein the support structure extends outwardly from the fire sprinkler in front of the exhaust port" (emphasis added). As set forth above regarding claim 1, neither *Katz* nor *MacDonald III* discloses a bladder for sealing an exhaust port of a fire sprinkler discharge head by contacting an outer surface of the at least one bladder with the exhaust port.

Furthermore, neither *Katz* nor *MacDonald III* discloses a bladder configured to be positioned between support structure of a fire sprinkler, wherein the support structure extends outwardly from the fire sprinkler in front of the exhaust port. Thus, for at least this reason, claim 13 is allowable. Claim 19 depends directly from claim 13 and is therefore, allowable as well.

Thus, the Examiner is respectfully requested to withdraw the rejection and issue a Notice of Allowance.

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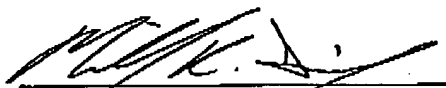
CONCLUSION

For at least the reasons given above, claims 1-25 define patentable subject matter and are thus allowable.

Should the Examiner believe that anything further is necessary in order to place the application in better condition for allowance, the Examiner is respectfully requested to contact the undersigned representative at the telephone number listed below.

No fees are believed due; however, the Commissioner is hereby authorized to charge any deficiency, or credit any overpayment, to Deposit Account No. 50-0951.

Respectfully submitted,



Michael K. Dixon
Registration No. 46,665
AKERMAN SENTERFITT
222 Lakeview Avenue - Suite 400
West Palm Beach, FL 33402-3188
(561) 653-5000

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